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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,258	09/04/2003	Bruce R. Fraedrich	3108/2	6157

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Adams Evans P.A.
2180 Two Wachovia Center
Charlotte, NC 28282

EXAMINER

ALIMENTI, SUSAN C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/655,258	Applicant(s) FRAEDRICH ET AL.	
	Examiner Susan C. Alimenti	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6 and 11 is/are rejected.
- 7) ☒ Claim(s) 4-5 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Beaver (US 5,827,235).

Regarding claim 1, Beaver discloses a reusable injector comprising a sealed housing 22 defining a reservoir 44, 48 for containing a pressurized fluid, an elongated neck 54 having an inner neck 52 in fluid communication with said reservoir 44, 48 and an outer end 58 defining a nozzle. An inlet valve 38 is disposed in said housing 22 for receiving a fluid therein. A control valve 50 selectively closes (Beaver, Figure 5) and prevents flow of a pressurized fluid between the reservoir 44, 48 and the nozzle 58. Control valve 50 further allows fluid flow out of the nozzle 58 by opening (Figure 6) and permitting fluid communication between said reservoir 44, 48 and said nozzle 58.

Regarding claim 11, an over pressure plug 46 is disposed in and in fluid communication with the housing 44 and serves as a relief vent when the pressure of the fluid exceeds a predetermined level. The statements of intended use in claim 11 are considered as reading on the teachings in Beaver (e.g. See col.3, lns.60+) of overcoming or relieving vacuum pressure.

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It is noted that applicant's arguments are essentially directed to applicant's desired manner or method of operation. Applicant's claims, however, are actually directed to an apparatus, per se (such as an apparatus sitting on a shelf, an apparatus which has just rolled off an assembly or manufacturing line, etc.).

As admitted by applicant on page 9 of the arguments filed 2/7/05, the movement of piston 30 of Beaver *creates pressure* and thus any fluid in the reservoir would *inherently* be contained under pressure of the piston. As to features which are considered inherent in a reference, note the case law recited in In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 266, In re Fitzgerald, 205 USPQ 594, In re Best et al., 195 USPQ 430, and also In re Brown, 173 USPQ 685, 688.

As already mentioned above, applicant claims contain statements of intended or desired use. It is well settled case law that such limitation, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See: In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the *structural* limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), see also: In re Swinehart, 439 F.2d 210,

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212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Huang (US 2002/0184819 A1).

Huang discloses a reusable injector comprising a sealed housing defining a reservoir 1, said housing including an elongated neck having an inner end 14, defining a tapered seating surface, and an outer end 10 defining a nozzle. An inlet valve 15 is disposed in said housing in fluid communication with said reservoir 1 for receiving a fluid therethrough. Control valve 2 comprises a shaft 220 having an upper end and a lower end including a tapered nose portion 22. The nose portion acts as a seal when in the position shown in Figure 4. The housing further comprises an open top end defined as the end opposite that in which the nozzle 10 is disposed and sealed by a cap defined as the planar disc in which inlet valve 15 is disposed.

Control valve 2 selectively prevents the flow of a pressurized fluid from reservoir 1 when tapered portion 22 is seated in tapered seating surface 14 and blocks fluid communication between said reservoir 1 and said nozzle 10 (Huang, Figure 7). Further control valve 2 selectively allows a flow of pressurized fluid out of said nozzle 10 by permitting fluid communication between said reservoir 1 and said nozzle 10 (Figure 4).

Allowable Subject Matter

4. Claims 4-5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive. See the above modified 37 U.S.C. 102(b) rejection as anticipated by Beaver for explanation.

6. The 37 U.S.C. 102(b) rejection as anticipated by Selenke has been withdrawn in response to the amendment filed 2/7/05.

7. Wang is cited for further showing of pertinent art.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

89. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 571-272-6897.

The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harvey Behrend can be reached on 571-272-6871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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